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FAX # 512

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SEND TO: United States Patent Office
Examiner: Q. Tran
Group Art Unit: 2176
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746 -

FROM: J. B. KRAFT
Tel No: 512- 473-2303

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Docket No. AUS920000928 Serial No. 09/179,537 Atty: JBKRAFT
Applicant: D. N. Bzuerjee

<u>2</u> Transmittal Letter (2 copies)	_____ Certificate of Facsimile
_____ Preliminary Amendment	_____ Notice of Appeal
<u>1</u> Amendment 2	_____ Appeal Brief (3 copies)
_____ Ext. of Time	_____ Reply Brief
_____ IDS Statement	_____ Change of Address
_____ Other _____	

Deposit Acct. No. 09-0447

Fees: Amendment _____ Notice of Appeal _____ Appeal Brief _____ Other _____

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: D. N. Banerjee et al.

DOCKET NUMBER: AUS920000928US1

Date: 6/25/04

Serial No.: 09/779,357

Filed: February 8, 2001

For: PRIORITIZING AND VISUALLY DISTINGUISHING SETS OF HYPERLINKS IN HYPERTEXT WORLD WIDE WEB DOCUMENTS IN ACCORDANCE WITH WEIGHTS
BASED UPON ATTRIBUTES OF WEB DOCUMENTS LINKED TO SUCH HYPERLINKSCOMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Response in the above-identified Application.

☒ No additional fee is required.☐ The fee has been calculated as shown below:

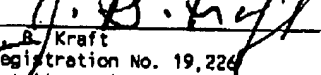
	Claims Remaining After Amendment		Highest No. Previously Paid For		Present Extra	Rate	Addit. Fee
Total	39	MINUS	39	=	0	x 18 =	\$0
Indep.	3	MINUS	3	=	0	x 86 =	\$0
1st Presentation of Multiple Dep. Claim						x 290 =	\$0
TOTAL							\$0

Please charge my Deposit Account No. 09-0447 in the amount of \$. A duplicate copy of this sheet is enclosed.

The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account 09-0447. A duplicate copy of this sheet is enclosed.

☒ Any additional fees required under 37 CFR 81.16 for the presentation of extra claims.☒ Any patent application processing fees under 37 CFR 81.17.

Respectfully submitted,

By 
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2176
: Examiner Q Tran
Dwip N. Banerjee et al. : Intellectual Property
Serial No: 09/779,357 : Law Department - 4054
Filed: February 8, 2001 : International Business
Title: PRIORITIZING AND : Machines Corporation
VISUALLY DISTINGUISHING SETS : 11400 Burnet Road
OF HYPERLINKS IN HYPERTEXT : Austin, Texas 78758
WORLD WIDE WEB DOCUMENTS IN :
ACCORDANCE WITH WEIGHTS BASED :
UPON ATTRIBUTES OF WEB :
DOCUMENTS LINKED TO SUCH :
HYPERLINKS :
Date: 6/25/04 :

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including the present Amendment and accompanying Transmittal letter is being transmitted via facsimile to USPTO, Group Art Unit 2176 at telephone number 703-746-7238, and to the attention of Examiner Q. Tran on 6/25/04.

J. B. KRAFT

Signature

Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

AUS920000928US1

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This is in response to the Official Action mailed
March 25, 2004.

Summary of Telephone Interview with Examiner on 06/16/04.

Applicants thank Examiner for the telephone interview extended to their attorney, J. B. Kraft on June 16, 2004. As Applicants explained in that interview, a rejection based on anticipation under 35 U.S.C. 102, must expressly or impliedly teach every element of invention without modification. The Examiner's application of the Adar et al. (US6,493,702) patent does not meet this standard. It was also pointed out that present Application and the Becker et al Patent (5,878, 223) used by Examiner in the rejection under 35 USC 103 were commonly owned by International Business Machines Corporation, the Assignee herein at the time the invention of the present Application was made. Thus, under 35 USC 103(c), the Becker patent could not be used to preclude patentability.

Applicants Argument

The rejection of claims 1-2, 6-15, 19-28, and 32-39 under 35 USC 102(e) as anticipated by Adar et al. (US6,493,702) is respectfully traversed.

A rejection based on anticipation under 35 U.S.C. 102, must expressly or impliedly teach every element of invention without modification. The Examiner's application of the Adar patent does not meet this standard. Every claim in the in this application requires that a plurality of hyperlinks in a Web document be prioritized and that each of this plurality of hyperlinks be visually distinguished based upon this prioritization.

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The Adar reference does not teach either of these elements. Adar does teach conducting a search via the Web, prioritizing the search results, and presenting the results to the user as a prioritized list of Web documents. There is no discussion whatsoever in Adar about hyperlinks, and certainly no discussion of prioritizing hyperlinks in a Web document and then visually distinguishing the documents based upon such prioritization.

Examiners Argument

In the above mentioned Interview, Examiner took the position that the prioritized documents resulting from a Web search presented to the user in Adar (column 16) was the teaching of the present invention required to anticipate under 35 USC 102. Applicants submit that the prioritized results were not prioritized hyperlinks in a received Web document. In connection with this, the Examiner's attention is directed to the Microsoft Computer Dictionary, Fifth Edition definition of the term "Hyperlink":

"A connection between an element in a hypertext document such as a word, a phrase, a symbol, or any image, and a different element in the document, another document, a file or a script."

Applicants submit that there is nothing disclosed in Adar's prioritized results matching a hyperlink as defined above.

For a disclosure of the claimed element of visually distinguishing the plurality of hyperlinks from each other based upon the prioritizing, Examiner only cites col. 9, lines 40-45 in Adar. Applicants submit that this section in Adar does not relate to the prioritized list of documents. Rather it relates to a process of grouping "the millions of users participating in the internet". The highlighting

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referred to is only used to distinguish groups of such users from each other. This does not disclose the claimed visually distinguishing prioritized hyperlinks in a Web or internet document.

In view of the foregoing, it is clear that the Adar patent fails to meet the requirements for a rejection based upon anticipation under 35 USC 102 i.e. the reference must expressly or impliedly teach every element of invention without modification. As Applicants pointed out in the interview, the Examiner might try to develop a rejection based upon obviousness under 35 USC 103 which includes the Adar patent. Until such a rejection is made, Applicants see no need to amend the claims as they are clearly patentable over Adar under 35 USC 103.

The Becker et al. Patent (US5,878,223 is Owned by the Assignee of the Present Application, and Thus Can Not Preclude Patentability Under 35 U.S.C. 103(c).

In this connection, the rejection of claims 3-5, 16-18, and 29-31 under 35 USC 103(a) is respectfully traversed.

The present Application and the Becker et al. Patent reference were commonly owned by International Business Machines Corporation, the Assignee herein at the time the invention of the present Application was made.

The file of the present Application indicates that an Assignment of the present Application to said Assignee is filed in the Patent Office. Also the printed Becker Patent indicates that it is assigned to the same Assignee.

Since the present Application has a filing date after November 29, 1999, and the Becker Patent would qualify as prior art under the provisions of 35 U.S.C. 102(e), it is submitted that the Becker patent can not be used to preclude

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patentability based upon 35 U.S.C. 103(c). [Examiner's attention is directed to MPEP Sections 706.02(1); (1)(1); (1)(2); and (1)(3).]

Accordingly, Examiner is respectfully requested to withdraw Becker as a reference. Examiner concedes, Adar does not teach varying the brightness or color or blinking of the hyperlinks to visually indicate the prioritization of the hyperlinks. The Becker et al. reference is not available to make up for these deficiencies in Adar.

In view of the foregoing, it is submitted that claims 1-39 are in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted

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